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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,643

01/20/2004

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1001.1735101

5318

28075 7590 05/11/2010
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EXAMINER

SEVERSON, RYAN J

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

05/11/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/762,643
Filing Date: January 20, 2004
Appellant(s): PETERSEN, SCOTT

Glenn M. Seager
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/9/2010 appealing from the Office action mailed 6/19/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 2, 5, 6, 9, 16, 17, 19-21, 24, 25 and 33-36 are rejected.

Claims 3, 7, 18, 22, 23 and 26 are withdrawn from consideration.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,007,558	Ravenscroft et al.	12-1999
6,342,062	Suon et al.	01-2002
6,273,901	Whitcher et al.	08-2001
6,482,221	Hebert et al.	11-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 16, 17, 20, 21, 25 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ravenscroft et al. (6,007,558) in view of Suon et al. (6,342,062).

Ravenscroft et al. disclose the filter (10) substantially as claimed, including: an apical head (12) and filter legs, with each filter leg including a joined end section (at 12) and a free end section (opposite 12). Each filter leg also includes a support member (32) coupled to an anchoring member (28) to secure the filter to the inner wall of the vessel. The filter also contains a plurality of filter tubes (26) with an inner lumen that receives the support members (see Figures 4-6). The filter tubes are joined at one end

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by a hub (see Figure 8, Ref. Numeral 38). However, Ravenscroft et al. do not disclose the claimed retrieval means for retrieving the filter.

Attention is drawn to Suon et al., who teach the expandable filter may be retrieved using a retrieval device (see figure 6) to allow the filter to be removed and/or repositioned if desired. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a retrieval device, as taught by Suon et al., with the filter of Ravenscroft et al., to allow the filter to be removed and/or repositioned if desired. The retrieval device of Suon et al. has a tubular inner member (51), a tubular middle member (60) that is *capable* of engaging the hub, and an outer sheath (40) for encapsulating the filter.

Claims 1, 2, 5, 6, 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ravenscroft et al. (6,007,558) in view of Suon et al. (6,342,062) and Whitcher et al. (6,273,901). The combination of Ravenscroft et al. and Suon et al. does not disclose the filter further comprising a landing pad secured to the free end of each filter tube. Attention is drawn to Whitcher et al., who teach a landing pad (see Figure 8, Ref. Numeral 42A) may be used at the free end of a filter to spread the force applied at the tips of the filter over a greater area, thereby reducing the pressure on the contact or grasping points. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the landing pads of Whitcher et al. to the filter tubes of the combination of Ravenscroft et al. and Suon et al. to allow the hook (28) of the support member to pass through to spread the force applied at the

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tips of the filter over a greater area, thereby reducing the pressure on the contact or grasping points.

Further, one of ordinary skill in the art would have recognized the need to secure the pads to the tubes and not the legs to still allow the Ravenscroft et al. filter to function as intended (i.e. allowing the legs to be retracted and moveable to and through the filter tubes). If this were not the case, when the legs of Ravenscroft et al. are retracted into the tubes, the pads would simply be loose in the vessel, and one of ordinary skill in the art would have recognized the need to avoid this situation.

Claims 24 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ravenscroft et al. (6,007,558) in view of Suon et al. (6,342,062) as applied to claims 16 and 35 above, and further in view of Hebert et al. (6,482,221). The combination of Ravenscroft et al. and Suon et al. does not disclose the inner member of the retrieval device of Suon et al. comprises a braided tubular member. Attention is drawn to Hebert et al., who teach a tubular member is made of a braided material (see Column 8, Lines 55-56) to provide varying flexibility to the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the inner member of the retrieval device of Suon et al. with a braided material, as taught by Hebert et al., to provide varying flexibility to the device.

(10) Response to Argument

Initially, Examiner notes appellant has made a statement (on page 10 of the appeal brief) that “Instead, Examiner has asserted that it would have been obvious to replace the retrieval apparatus and thermally activated hook withdrawing washers of the filter of Ravenscroft et al. with a retrieval apparatus of Suon.” However, this statement is incorrect, as Examiner never suggested removing the washers from the Ravenscroft et al. device. Rather, Examiner stated that it would have been obvious to use a retrieval device (as taught by Suon et al.) with the filter device (as shown in figure 8 of Ravenscroft et al.). There was no suggestion of further modification beyond that in the rejection.

Appellant argues Examiner improperly relied upon inherency to meet the limitation in the claims requiring the middle tubular member **configured** to engage the hub. (emphasis added) However, Examiner never stated that the middle tubular member inherently contacts the hub. Rather, Examiner stated that the middle tubular member is *capable* of engaging the hub. This is not a statement of inherency; rather it is a statement that the claimed structures can perform the claimed function. Examiner notes here that the claims do not specify how the hub is engaged, where it is engaged, or at what point in time it is engaged. It is the Examiner's position that since the washers (40) and hub (38) have the same diameter, the inner surface of the tubular member of Suon et al. is capable of contacting the hub at a point around its circumference. For example, this is capable of happening if a person manually held the filter and touched it to the inner surface of the middle tubular member. The claims do not require this

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contact to occur within a blood vessel or during a surgical procedure. Further, the claims do not require the contact to occur at the same time the inner member is grasping the apical head, and so the argument that contact couldn't occur because the inner member is engaged with the apical head is not persuasive.

Appellant argues the filter of Suon et al. does not have filter tubes or a hub to which the tubes are coupled. However, Suon et al. was not relied upon for this teaching, and therefore this argument is not persuasive. Ravenscroft et al. disclose these features as set forth in the rejections above.

Examiner notes here that structure 12 of Ravenscroft et al. was not relied upon as the hub (as stated by appellant at the bottom of page 11 of the brief). Rather, 12 is the apical head and 38 is considered the hub. Further, it was never suggested to resize the middle tubular member of Suon et al. to match the diameter of the hub of Ravenscroft et al.

Appellant argues with respect to Whitcher et al. that if the landing pads were secured to the shafts 32 of Ravenscroft et al. it would render the filter of Ravenscroft et al. unsuitable for its intended purpose because the shafts would not be able to be withdrawn into the filter tubes 26. However, Examiner never suggested attaching the landing pads to the shafts 32. Rather, Examiner suggested attaching the landing pads to the tubes 26. Since the landing pads (42A) of Whitcher et al. have a hole (44) in the center, the ends of the shafts 32 could pass through the pad to anchor to the vessel wall without destroying the function of the filter of Ravenscroft et al.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ryan J Severson/

Examiner, Art Unit 3731

Conferees:

/Anhtuan T. Nguyen/

Supervisory Patent Examiner, Art Unit 3731

/Thomas C. Barrett/

Supervisory Patent Examiner, Art Unit 3775